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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,559	07/16/2003	Yusho Taguchi	088473-0138	5936

22428 7590 06/30/2005

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

LEWIS, TISHA D

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/619,559	Applicant(s) TAGUCHI ET AL.	
	Examiner TISHA D. LEWIS	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The following is a first action on the merits of application serial no. 10619559, filed on July 16, 2003.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on July 16, 2002. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b). Only the front page of the document was received and the examiner will need the entire document or at least the drawings to determine if the priority document is the same as the present invention.

Information Disclosure Statement

The information disclosure statements filed on July 16, 2003 and April 8, 2005 have been acknowledged.

Claim Objections

Claims 4-8, 13 and 14 are objected to because of the following informalities:

-In claim 4, line 3, before "corresponding", "a" should be changed to -the- since this limitation was already introduced in claim 1 (following changes in other claims pertain to this situation also).

-In claim 5, line 2, before "brake pack", "a" has been changed to -the-.

-In claim 5, line 3, before "corresponding", "a" should be changed to -one-.

-In claim 5, line 4, before "brake pack", "a" has been changed to -the-.

-In claim 5, line 5, before "corresponding", "a" should be changed to -the other-.

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- In claim 6, line 3, before "corresponding", "a" should be changed to -the-.
- In claim 7, line 3, before "corresponding", "a" should be changed to -the-.
- In claim 8, line 3, before "corresponding", "a" should be changed to -the-.
- In claim 13, line 3, after the comma and before "set of plates", "a" should be changed to -the-.
- In claim 13, line 5, before "set of plates", "a" should be changed to -the-.
- In claim 14, lines 2 and 3, before "set of plates", "a" should be changed to -the-.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuga, Figure 10 ('635) and Figures 10-11 ('087), Ikeda Figures 3-6 ('552) and Choi Figure 6 ('549). Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The above references disclose an automatic transmission having at least six forward speeds, an input member (1) which inputs an engine rotation, a planetary gear

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train to receive the engine rotation from the input member and having a first planetary gearset (G1) acting as a reduction gearset inputting engine rotation from the input member, a second planetary gearset (G2) disposed behind the first gearset and having a sun gear (S2), planetary pinions (P2) meshing with the sun gear, a pinion carrier (PC2) supporting the pinions and a ring gear (R2) acting as the input member from the first gearset, a third planetary gearset (G3) disposed behind the second gearset and having two sun gears (S3 and S4), common planetary pinions (P3) meshing with the two sun gears, a pinion carrier (PC3) supporting the pinions, a ring gear (R3), an output member (22) disposed coaxially with the input member and receiving rotation from the planetary gear train, three clutches (C1-C3) and two brakes (B1 and B2) wherein two of the clutches are disposed around the planetary gear train, the two brakes are disposed around the two clutches in which one of the clutches and one of the brakes overlap partially and the other clutch and the other brake overlap at least partially.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11, 12, 15, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07317853A in view of Taniguchi et al ('069). The Japanese reference discloses an automatic transmission having an input member (2) inputting

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rotation from an engine, a planetary gear train receiving rotation from the engine and having a first planetary gearset (4) acting as a reduction gearset, a second planetary gearset (5) having a sun gear (5s), common planetary pinions (5p) meshing with the sun gear, a pinion carrier (5c) supporting the pinions, a ring gear (5r) acting as an input member from the first gearset, a third planetary gearset (6) having a sun gear (6s), planetary pinions (6p) meshing with the sun gear, a pinion carrier (6c) supporting the pinions, a ring (6r), an output member (3) receiving rotation from the geartrain and three clutch packs (C1-C3) axially disposed in a row and two brake packs (B2-B3) axially disposed in a row.

Although the Japanese reference does disclose a double sun gear arrangement, it is with the second gearset and not the third as claimed in claim 16 and the reference also lacks the clutches and brakes overlapping.

Taniguchi et al discloses an automatic transmission having six forward speeds and a reverse speed, an input member (11) inputting rotation from an engine, a planetary gear train receiving the engine rotation and having a first planetary gearset (G1) acting as a reduction gearset, a second gearset (also acting as a third gearset, R3) disposed behind the first gearset and having two sun gears (S2 and S3) meshed with planetary pinions (P2, P3), a pinion carrier (C2, C3) supporting the pinions, a ring gear (R2), an output member (extending from R2) in the form of a drum axially disposed between clutches and brakes and receiving rotation from the planetary gear train and being joined to an output gear (19) meshing with a counter gear (21), the clutches and

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brakes have three clutches (C1-C3) and two brakes B1 and B2) wherein two of the clutches (C1 and C3 or C2) are disposed around the planetary gear train and the two brakes are disposed around the two clutches, one of the clutches (C2) and one of the brakes (B2) overlapping partially in the axial direction and the other clutch (C1 or C3) and the other brake (B1) overlapping partially in the axial direction.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a double sun gear arrangement for any of the planetary sets to provide more speed ratios without having to provide another entire planetary gearset and to provide the clutches and brakes in an overlapping arrangement in view of Taniguchi et al to compact or reduce axial size of the transmission.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Tdl

June 26, 2005


TISHA LEWIS
PRIMARY EXAMINER
AU 3681 6/24/05